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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re 200 Kelsey Associates, LLC

Serial No. 78499928

Edmund J. Ferdinand, III of Grimes & Battersby, LLP for 200 Kelsey Associates, LLC.

Sara N. Thomas, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Grendel, Drost and Kuhlke, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On October 14, 2004, 200 Kelsey Associates, LLC (applicant) applied to register on the Principal Register the mark BRANIFF, in standard character form, for "transportation of persons, property and mail by air" services " in Class 39. The application (Serial No. 78499928) is based on applicant's allegation of a bona fide intention to use the mark in commerce.

The examining attorney¹ refused to register applicant's mark on the ground that the mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act. 15 U.S.C. § 1052(e)(4).

After the examining attorney made the refusal final, applicant filed a notice of appeal.

Section 2(e)(4) of the Trademark Act prohibits the registration on the Principal Register of a mark that "is primarily merely a surname."

There are five accepted factors to be considered in the [surname] analysis:

- (1) Is the word a common or rarely used surname?
- (2) Does anyone connected with the applicant have that surname?
- (3) Does the word have meaning other than as a surname?
- (4) Does the word look and sound like a surname?
- (5) Is the word presented in use in a stylized form distinctive enough to create a separate non-surname impression?

In re Gregory, 70 USPQ2d 1792, 1794 (TTAB 2004).

We will address these factors as we consider the facts and arguments in this case. We begin by considering whether "Braniff" is a common or rare surname in the United States. The examining attorney submitted the results of a USFIND search that found 269 hits for the name "Braniff."

¹ The current examining attorney was not the original examining attorney in this case.

Included with this evidence was a printout of the first one hundred entries. The entries include individual's addresses, inter alia, in New York, NY; Richmond, TX; Washington, DC; Daytona, FL; Wichita, KS; Lakewood, CO; San Francisco, CA; and Los Banos, CA. Subsequently, the examining attorney attached a page from the "namestatistics" database that indicated that there were 1250 individuals with the last name "Braniff" in the United States.²

When we consider the evidence of the use of the name "Braniff" as a surname, we agree that it is somewhat rare. In re United Distillers plc, 56 USPQ2d 1220, 1221 (TTAB 2000) (Hackler held to be a rare surname despite 1295 listings in 80 million entry Phonedisc database) and In re Sava Research Corp., 32 USPQ2d 1380, 1380-81 (TTAB 1994) ("SAVA is indeed a rare surname" despite 100 different SAVAs among 90,000,000 listings). While a term may be a somewhat rare surname, it still may be primarily merely a

² With its brief, applicant submitted two pages from the www.namestatistics.com website. One appears to be a duplicate of a page submitted by the examining attorney that contains similar information. The second page simply shows the context of the examining attorney's information. Therefore, we overrule the examining attorney's objection. In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986) ("Let it be clear that by citing only a portion of an article, that portion is not thereby insulated from the context from whence it came").

surname. "The rareness or uncommonplace nature of a surname does not necessarily remove it from the category of a 'primarily merely surname' precluded by Section 2(e)(3) [now (4)] of the statute." In re Villiger Sohne GmbH, 205 USPQ 462, 466 (TTAB 1979). See also In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985) (The "examiner made of record evidence that others in a number of cities in this country bear the surname DARTY. Thus, as a surname, DARTY is not so unusual that such significance would not be recognized by a substantial number of persons").

Regarding the second factor, there is no evidence that anyone connected with applicant is named "Braniff" so this factor is neutral. Gregory, 70 USPQ2d at 1795 ("In a situation wherein an individual applicant, or an officer or employee, for example, of a corporate applicant, actually has the surname proposed as a mark, this would certainly weigh against the applicant... In contrast, that a proposed mark is not the applicant's surname, or the surname of an officer or employee, does not tend to establish one way or the other whether the proposed mark would be perceived as a surname").

The third factor is whether there is evidence that there is another recognized meaning of the term "Braniff."

Both the examining attorney and applicant have submitted evidence on this factor. The examining attorney, in the first Office action, provided an entry from the *Merriam-Webster Online Dictionary* that showed that there were no listings for the word "Braniff." Applicant submitted two pages from a website³ entitled *Braniff's Final Hours*. The pages describe the actions that "would bring the fifth-largest airline in the nation to a screeching halt." The date of the shutdown was May 12, 1982. Applicant (Brief at 6) "points to this evidence of the prior use of the mark to confirm that the mark at one time had (and likely still has) meaning and significance to the consuming public as a term other than as a surname (*i.e.*, as an airline)." ⁴ In response, the examining attorney relies on the case of In re McDonald's Corp., 230 USPQ 304 (TTAB 1986). In that case, the applicant "attempted to rebut the Examining Attorney's showing by introducing into the record a large amount of evidence which, applicant asserts, shows that the primary significance of the term 'MCDONALD'S' to the purchasing public is that of the restaurants owned by

³ www.braniffinternational.org.

⁴ Applicant also included copy of an expired registration for the mark BRANIFF. However, "a canceled registration does not provide constructive notice of anything." Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989).

applicant and applicant's licensees rather than that of a surname." Id. at 306. However, the board rejected this argument.

While at first blush, applicant's survey evidence appears to rebut the Examining Attorney's prima facie showing that "McDonald's" is primarily merely a surname, it is our opinion, upon further analysis, that the survey evidence is evidence of the distinctiveness that "MCDONALD'S" has acquired in the restaurant business as a consequence of the enormous advertising and promotion of the mark over the years, and the huge success of applicant's business and recognition by the public. We agree with the Examining Attorney that in referring to the concept of "primarily merely a surname" for purposes of Section 2(e)(3) of the Act, the word "primarily" refers to the primary significance of the term, that is, the ordinary meaning of the word, and not to the term's strength as a trademark due to widespread advertising and promotion of the term as a mark to identify goods and/or services... The Board readily concedes that the association of "MCDONALD'S" as a source indicating trademark and service mark has probably overtaken the original meaning of the word as a surname. However, this is due to the distinctiveness that has been acquired by the term over the years. A term's secondary meaning does not necessarily mean second in importance or significance but, merely, second in time.

Id. at 307.

Similarly, we cannot agree with applicant that the surname significance of the term BRANIFF is not the primary significance of the term. Even if a surname's association with a service mark could overcome the primary surname significance of the term, applicant's evidence would not be adequate to establish this non-surname significance in this

case. Unlike the McDonald's case, applicant's own evidence indicates that the previous airline ceased operations more than twenty years ago and there is no evidence of any recognition now of the term as anything other than a surname. Therefore, we conclude that this factor favors the examining attorney's position.

The final factor we will consider is whether the term has the "look and feel" of a surname.⁵ Applicant argues (Brief at 7) that "the question whether the BRANIFF mark has the 'structure and pronunciation' of a surname is an entirely subjective inquiry. Applicant submits that this factor is neutral." The examining attorney maintains (Brief at unnumbered p. 7) that the term "does not resemble words in the English language that have a specific, dictionary meaning. Similarly, it is not a term that is composed of other terms or portions of terms, such as common prefixes and suffixes that convey a particular meaning." The evidence in this case leads us to resolve this factor in favor of the examining attorney's position. The term has no other meaning and it does not appear to be an arbitrary or coined term. While this is a subjective

⁵ Inasmuch as the mark is displayed in standard character form the fifth factor (Is the word presented in use in a stylized form distinctive enough to create a separate non-surname impression?) is not applicable.

determination, we conclude that the term does have the "look and feel" of a surname. See Gregory, 70 USPQ2d at 1796 ("We conclude that ROGAN has the look and sound of a surname. It would not be perceived as an initialism or acronym, and does not have the appearance of having been coined by combining a root element that has a readily understood meaning in its own right with either a prefix or a suffix. Rather, ROGAN appears to be a cohesive term with no meaning other than as a surname") (footnote omitted).

There is one other point that we need to mention regarding the term BRANIFF. This is not the first time that the board has reached this conclusion. Previously, the board determined that the BRANIFF was primarily merely a surname for "tobacco products, namely, cigars, cigarillos and stogies." Villiger Sohne, 205 USPQ at 463. The board noted that: "Insofar as the third-party registrations are concerned, most, if not all, as demonstrated by the Trademark Attorney, issued on the Principal Register under the provisions of Section 2(f) of the statute which indicates that 'BRANIFF,' as used in the registered marks, was held initially to be primarily merely a surname and registrable thereafter only upon a showing of secondary meaning or distinctiveness." Id. at 466. Interestingly, even while the airline applicant refers to in its evidence

was still operating, the board nonetheless found that the term BRANIFF was primarily merely a surname.

Similarly, the evidence in this case demonstrates that the Office has met its initial burden of showing that the term BRANIFF would primarily be viewed as a surname.

Inasmuch as applicant has not rebutted the examining attorney's prima facie case, we conclude that the mark is primarily merely a surname.

Decision: The refusal to register applicant's mark BRANIFF on the ground that it is primarily merely a surname is affirmed.